

Application No.: 09/450,236
Amendment Dated: December 5, 2003
Reply to Office Action of: September 9, 2003

MAT-7867US

Remarks/Arguments:

By this Amendment, Applicant has amended claims 1, 6, 11, 15 and 17. Applicant has also added new claims 29-32. Claims 1-32 are pending.

Claim Rejections Under § 102

Claims 1-14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Yamashita. By this Amendment, Applicant respectfully traverses the Section 102(b) rejection.

Applicant notes that the Examiner identifies the Yamashita Patent as U.S. Patent No. 5,146,354. Applicant believes that this is merely a typographical error and that the Examiner meant U.S. Patent No. 5,146,345.

Claims 1, 6, 11, and 13 are independent claims. Claims 2-5 are dependent on claim 1; claims 7-10 are dependent on claim 6; claim 12 is dependent on claim 11; and claim 14 is dependent on claim 13.

Turning first to independent claim 1, it is directed to an electronic print board apparatus and includes the following elements:

- a writing medium having a writing surface where image information is written on the writing surface,
- reading means for reading the image information,
- printing means for printing the image information read by the reading means onto a printing medium, and
- **control means for controlling driving of the reading means according to driving of the printing means.**

Applicant contends that the electronic print-board apparatus of claim 1 is patentably distinguished from the Yamashita Patent at least based on the feature of the control means controlling driving of the reading means according to driving of the

printing means. It is Applicant's contention that this feature is neither taught nor suggested in the Yamashita Patent.

The Yamashita Patent in general relates to a foldable electronic print board which copies or records, on recording paper, patterns of information. The foldable electronic print board of Yamashita has a pair of hinged cases housing the writing sheet, and a printer for printing the handwritten information on recording paper. The printer is detachably mounted on the cases across the access about which the print board is foldable, to keep the print board unfolded. Because the printer itself is used to hold the print board unfolded, no dedicated holder or holders are required to be fixed to the cases.

More specifically, the Yamashita Patent concerns a foldable electronic print board including a writing medium as an endless writing sheet (see column 3, line 2), a photoelectric reader 22 (see column 3, line 10, and column 5, line 13), a printer 5 (see column 3, line 12), and a control unit 5d for controlling the entire operation of the electronic print board (see column 3, lines 37-38). The control unit 5d controls the printer mechanism 5e to print information on the recording paper 5i (see column 5, lines 17-19).

The Office Action states at numbered paragraph 2 (page 2) that the Yamashita Patent discloses "control means for controlling said reading performed by said reading means responsive to said printing means (please note Fig. 3, item 5d[,], the controller which controls the entire function of electronic board, column 3[,], lines 35, 38)". Applicant respectfully disagree with this position.

The Yamashita Patent at column 3, lines 35-42 states the following:

As shown in FIG. 3, the printer 5 has a connector 5b, a printer mechanism 5e, a power source 5c including a transformer, and a control unit 5d for controlling the entire operation of the electronic print board 20. The connected (*sic.*) 5b is connected to the control unit 5d by a cable 5g. The power source 5e can be connected to a

commercial power supply by a plug 5f. The recording paper 5i is supplied from a paper roll 5h. (Emphasis added.)

This statement in the Yamashita Patent merely states that the control unit 5d controls the entire operation of the electronic print board 20. The only specificity disclosed by Yamashita relative to the control unit 5d is found at column 5, lines 17-21, which reads as follows:

The control unit 5d controls the printer mechanism 5e to print the information on the recording paper 5i, which is then discharged through the outlet slot 5a.

From this disclosure of the Yamashita Patent, there is simply no teaching or suggestion of the feature of Applicant's claim 1 of "control means for controlling driving of said driving means according to driving of the printing means". No disclosure of this feature is present in the Yamashita Patent, and to make such leap (as does the Office Action) is simply not based on any evidence or any inference found in the Yamashita Patent. Because the above note feature of claim 1 is not taught or suggested in the Yamashita Patent, the Yamashita Patent can neither anticipate nor render obvious the electronic print-board apparatus of claim 1 as well as that set forth in dependent claims 2-5.

Applicant's independent claim 6 includes among its features the following:

"... control means for controlling driving of said printing means according to driving of said reading means."

Applicant's independent claim 11 includes among its features the following:

"... control means for controlling print starting time of said printing means for synchronization with reading starting time of said reading means."

And independent claim 13 includes among its features the following:

Application No.: 09/450,236
Amendment Dated: December 5, 2003
Reply to Office Action of: September 9, 2003

MAT-7867US

"control means for controlling reading starting time of said reading
means for synchronization with print starting time of said printing
means."

Each of the above-identified features of independent claims 6, 11 and 13 are simply not found or suggested in the Yamashita Patent.

The Office Action, for example, at the bottom of page 3 states with respect to claims 6, 11 and 13 that the Yamashita Patent discloses "... Control means for controlling printing performed by said printing means responsive to said reading means (please note Fig. 3, item 5d[,]) the controller which controls the entire function of electronic board, column 3, lines 35-38)". But as noted above, the quoted portion of the Yamashita Patent does not teach or suggest the specific operation of the controlling means relative to the printing means and the reading means, as set forth in claims 6, 11 and 13. Applicant therefore contends that independent claims 6, 11 and 13, as well as dependent claim 7-10, 12 and 14, are patentably distinguished from the Yamashita Patent for the reasons noted above.

Applicant notes that the above quoted portion of page 3 is similarly stated with respect to the other claims of Applicant's claimed invention. But as Applicant repeats, there is simply no teaching or suggestion of this feature from the very broad and unclear statements identified by the Examiner (and quoted above) with respect to the Yamashita Patent.

Based on the foregoing remarks, Applicants requests that the Section 102(b) rejection of claims 1-14 based on the Yamashita Patent be withdrawn.

Claim Rejections Under § 103

Claims 15 and 17-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamashita in view of Wierszewski. Based on this Amendment, Applicant respectfully traverses this Section 103(a).

Independent claim 15 is directed to an electronic print-board apparatus and includes among its features the following:

- a transportation system including transportation time adjustment means for the paper sheet for allowing a printing operation to be initiated in synchronization with initiation of reading operation of said image by said reading device.

The Office Action at page 5 appears to state that the Yamashita Patent does not teach or disclose this feature of Applicant's independent claim 15. Applicant agrees. The Office Action, however, goes on to take the position that the Wierszewski Patent discloses such feature. Applicant respectfully disagrees.

The Wierszewski Patent, in general, relates to an electro-photographic printing machine including a mechanism to feed through sheets. In addition, the Wierszewski Patent, in general, relates to a method for synchronizing the feeding of an insert by a first drive mechanism with a sheet feed by a second feed mechanism and the first feed mechanism. But Applicant's claim 15 requires a transportation system with a time adjustment means for the paper sheet for allowing a printing operation to be initiated in synchronization with initiation of reading of the image by the reading device. There is simply no teaching or suggestion in the Wierszewski Patent of this feature. The Wierszewski Patent only teaches the method of synchronizing the insertion of sheets for an electro-photographic machine, and not the transportation system with a time adjustment means as required by Applicant's claim 15. This feature is, of course, not taught by the Yamashita Patent.

Independent claim 17 is a method claim which includes among its steps the following:

- controlling at least one selected from the group consisting of the reading means, the printing means and a feeding means in such manner that reading starting time for the reading means to start reading next written information and print starting time for the printing means to start printing to the second printing sheet are coincidental with each other.

Application No.: 09/450,236
Amendment Dated: December 5, 2003
Reply to Office Action of: September 9, 2003

MAT-7867US

Applicant contends that the above-identified step is neither taught nor suggested by the Yamashita and the Wierszewski Patents. It appears to Applicant from the Office Action at page 6 that the Examiner agrees that the above-identified step of independent claim 17 is not taught by the Yamashita Patent. But the Office Action appears to indicate at page 6 that this feature is taught by the Wierszewski Patent. Applicant respectfully disagrees. It is Applicant's position that nowhere in the Wierszewski Patent is there any teaching or suggestion of the controlling step as defined in Applicant's claim 17; namely, the reading start time and the printing start time being coincidental. Because this step is not taught in the Wierszewski Patent, the Wierszewski Patent in combination with the Yamashita Patent can neither anticipate nor render obvious Applicant's claim 17, as well as dependent claim 28.

For the reasons stated above, Applicant respectfully submits that claims 15 and 17-28 are neither anticipated nor obvious in view of the Yamashita and Wierszewski Patents. Applicant therefore requests that the Section 103(a) rejection be withdrawn.

Allowable Subject Matter

Applicant acknowledges with appreciation the Examiner's finding that claim 16 includes allowable subject matter and would be allowed if rewritten in independent form. Rewriting claim 16 in independent form is not necessary because claim 16 is directly dependent on claim 15 which is itself in condition for allowance.

Newly Added Claims

By this Amendment, Applicant has added new claims 29-32. Claims 29-32 are respectively dependent on claims 1, 6, 11 and 13. In addition, each of these dependent claims 29-32 include the subject matter of claim 16 which the Examiner has found to be allowable. Applicant therefore contends that new claims 29-32 are in condition for allowance.

Application No.: 09/450,236
Amendment Dated: December 5, 2003
Reply to Office Action of: September 9, 2003

MAT-7867US

Based on the foregoing remarks and amendments, Applicant respectfully submits that claims 1-32 are in condition for allowance. Reconsideration and allowance of all pending claims are respectfully requested.

Respectfully submitted,

RatnerPrestia

Daniel N. Calder

Lawrence E. Ashery, Reg. No. 34,515
Daniel N. Calder, Reg. No. 27,424
Attorneys for Applicant

DNC/fp/kc

Dated: December 5, 2003

P.O. Box 980
Valley Forge, PA 19482-0980
(610) 407-0700

The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. **18-0350** of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

December 5, 2003

Daniel N. Calder
